

1103326-0576

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Balganesch et al.
Serial No. : 09/355,296
Filed : July 28, 1999
For : RNA POLYMERASE ASSAY
Examiner : Ja-Na A. Hines
Group Art Unit : 1645

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MAY 17 2005

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§1.8	
I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below at the facsimile number <u>703-872-9306</u> .	
Richard J. Sterner	35,372
Agent Name	PTO Reg. No.
<i>Richard J. Sterner</i>	May 17, 2005
Signature	Date of Signature

Attention: Petitions Branch
Facsimile No.: 703-872-9306
No. of Pages: 15

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Sir:

This is in response to the Notice of Abandonment mailed March 17, 2005. This Notice was issued in error and the application should be reinstated to its rightful status for the reasons set forth below.

The prosecution of this application has been delayed time and again due to PTO mishandling, and the present situation is no exception.

As can be seen from the PAIR File History, copy enclosed, for this application, a Notice of Abandonment was issued by the Office on October 2, 2000 on the grounds that Applicants had failed to respond to the Notice to Comply mailed February 2, 2000. Applicants were then obliged to respond to these erroneously issued Notices, and did so on October 11, 2000. On September 18, 2001, the Office issued a Withdrawal of the Notification of Abandonment, acknowledging that the February 2, 2000 Notice to Comply had been issued inappropriately and vacating the October 2, 2000 Notice of Abandonment. A copy of the September 18, 2001 Withdrawal of the Notification of Abandonment is also provided herewith.

On February 14, 2002, the Office properly mailed a Notification of Missing Requirements stating that a CRF of the Sequence Listing had not been submitted.¹ Applicants timely responded, on March 20, 2002, to the February 14, 2002 Notification. The Response included a CRF of the sequence

¹ In connection with this, and as an indication of the Office's mishandling and confusion, Applicants point out a PAIR File History entry dated July 28, 1999 stating "CRF Disk Has Been Received by Preexam/Group/PCT"; in fact, however, no disk had ever been submitted by Applicants at the time the February 14, 2002 Notification was issued, and issuance of that Notification was justified.

listing. A copy of the Response (excluding CRF) is provided herewith.

As can be seen in the attached PAIR File History, there is an entry dated March 25, 2002 that "CRF Disk Has Been Received by Preexam/Group/PCT" and an entry dated May 31, 2002 that "CRF Is Good Technically/Entered into database." Furthermore, on April 22, 2003 the Office issued a Notice of Acceptance of Application indicating that, inter alia, the "Biochemical Sequence Diskette filed on 03/25/2002" had been received. Applicants note that it took the Office eleven months from the date it had found the CRF compliant with the rules to (it appeared at the time) formally accept the application.

The 4/22/03 Notice of Acceptance was accompanied by an official Filing Receipt and, astoundingly, a Withdrawal of Previously Sent Notice stating that "[I]t has come to the attention of the Office that the Notice mailed on 02/14/2002 was sent in error. Please disregard that Notice. The application is complete and will be processed for examination.... We apologize for any inconvenience this has caused." This incongruous Withdrawal Notice notwithstanding, the Office had provided ample indication in the form of various communications acknowledging that the application was considered ready for

examination, and Applicants felt confident that normal prosecution would begin.²

In light of Applicants' receipt of the Notice of Acceptance and the accompanying Withdrawal Notice stating that the application would be processed for examination, Applicants expected that the next Office communication would be in the form of an action reflecting examination on the merits. However, the next communication Applicants received was the March 17, 2005 Notice of Abandonment. Incredibly, the reason given for this action is "Applicant's failure to timely file a proper reply to the Office letter mailed on 2/2/00." [Emphasis added.]

Again, the 2/2/00 Notice to Comply to which Applicants failed to reply was erroneously issued in the first place; Applicants pointed this out in their October 11, 2000 response to the Notice of Abandonment; and, in the Office's September 18, 2001 Withdrawal of the Notification of Abandonment, it was acknowledged by the Office that the 2/2/00 Notice had been mailed prematurely and that it was therefore being vacated. Applicants are thus now obliged to respond to a Notice of Abandonment issued for failure to respond to a Notice vacated by

² Further demonstrating the Office's continuing confusion and mishandling, however, Mr. Rashmee Tadvalkar called on July 14, 2003 to inquire if Applicants had received a Notice of Rescinded Abandonment mailed September 3, 2002. Mr. Tadvalkar was informed that not only did Applicants have no record of having received such a communication, but that they had no idea, given the circumstances, why such a Notice would have been issued in the first place. Mr. Tadvalkar provided no enlightenment in this regard.

the Office more than 3½ years ago. Furthermore, again, Applicants fully responded to the Notification of Missing Requirements properly issued on February 14, 2002 and such was acknowledged by the Office in the form of a Notice of Acceptance.

As is clear from the facts set forth above, the outstanding Notice of Abandonment, like its predecessor, was issued in error and must be withdrawn. Also, it must be noted that this application, submitted to the DO/US on July 28, 1999, has yet to receive an examination on the merits. That nearly six years have since passed is due entirely to Office mishandling. It is respectfully requested that the application not only be reinstated but that it be given expedited processing to examination.

Applicants respectfully submit that the Office's handling of the subject application does not even meet a minimum standard of due care. In this case, Applicants have been irreparably harmed by the Office's demonstrated ineptitude. Surely, Applicants are entitled to relief for the wrongful erosion of patent term due to inexcusable delays attributable to the Office. Under the circumstances, Applicants are further entitled to expedited consideration and granting of this Petition.

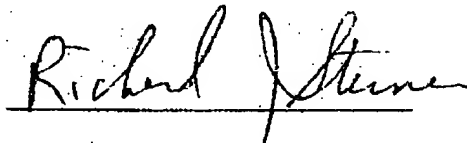
No fees should be due, since it is entirely through Office

error that this Petition is required in the first place.

However, should it be determined that a fee is required for any reason, the Commissioner is hereby authorized to charge it to Deposit Account No. 23-1703.

Dated: May 17, 2005

Respectfully submitted



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Enclosures



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PATENT APPLICATION INFORMATION RETRIEVAL



Search results as of: 5-17-2005:10:35:11 E.T.

Search results for application number: 09/355,296			
Application Number:	09/355,296	Customer Number:	7470
Filing or 371(c) Date:	07-28-1999	Status:	Abandoned -- Failure to Respond to an Office Action
Application Type:	Utility	Status Date:	03-16-2005
Examiner Name:	HINES, JANA A	Location:	TC 1600 INCOMING MAIL, REM 00A89
Group Art Unit:	1645	Location Date:	03-29-2005
Confirmation Number:	6228	Earliest Publication No:	-
Attorney Docket Number:	1103326-0576	Earliest Publication Date:	-
Class/ Sub-Class:	435/007.32	Patent Number:	-
First Named Inventor:	Tanjore Balganes, Bangalore, (IN)	Issue Date of Patent:	-
Title Of Invention:	Method of identifying ligands to rna polymers sigma 70 subunit		

Search Options

Assignments
Continuity Data
Foreign Priority
Image File Wrapper

File History	
Date	Contents Description
03-17-2005	Mail Abandonment for Failure to Respond to Office Action
03-16-2005	Abandonment for Failure to Respond to Office Action
04-22-2003	Notice of DO/EQ Acceptance Mailed
07-28-1999	Additional Application Filing Fees
07-28-1999	Copy of the International Preliminary Examination Report
07-28-1999	Copy of the International Search Report
07-28-1999	Copy of the International Application
07-28-1999	Additional Application Filing Fees
03-25-2002	CRF Disk Has Been Received by Preexam / Group / PCT
07-28-1999	Additional Application Filing Fees
12-27-1999	Information Disclosure Statements
07-28-1999	Additional Application Filing Fees

07-28-1999	CRF Disk Has Been Received by Preexam / Group / PCT
10-09-2002	Application Return from OIPE
09-03-2002	Application Return TO OIPE
09-03-2002	Mail Notice of Rescinded Abandonment
09-03-2002	Notice of Rescinded Abandonment in TCs
05-31-2002	CRF Is Good Technically / Entered Into Database
02-14-2002	Notice of DO/EO Missing Requirements Mailed
02-08-2002	Pre-Exam Office Action Withdrawn
09-18-2001	Petition Decision - Granted
10-16-2000	Petition Entered
10-02-2000	Mail Abandonment for Failure to Respond to Office Action
09-28-2000	Abandonment for Failure to Respond to Office Action
06-21-2000	Case Docketed to Examiner in GAU
12-27-1999	Information Disclosure Statement (IDS) Filed
02-02-2000	Mail Letter Requiring CRF (Unreadable, Non-Compliant, Not Submitted)
01-31-2000	CRF Diskette Unreadable / Did Not Comply / Required but Not Submitted
01-12-2000	Case Docketed to Examiner in GAU
12-15-1999	Application Dispatched from OIPE
12-11-1999	IFW Scan & PACR Auto Security Review
10-07-1999	Released to OIPE
10-07-1999	Notice of DO/EO Acceptance Mailed
10-07-1999	371 Application Preexamination Docketing
10-07-1999	371 Application Preexamination Docketing
09-29-1999	371 Application Preexamination Docketing
08-13-1999	IB Paper Match
08-11-1999	371 Application Preexamination Docketing
07-28-1999	Receipt of 371 Request

1103326-0576

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Balganesch et al. :
 Serial No.: 09/355,296 : Examiner: To be assigned
 Filed: June 7, 1999 : Group Art Unit: 1643
 Title: RNA POLYMERASE ASSAY

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I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents Washington, D. C. 20231.	
Thelma A. Chen Cleland	40,948
Name	Reg. No.
Thelma A. Chen Cleland	3/20/02
Signature	Date

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

BOX SEQUENCE

Assistant Commissioner for Patents
 Washington, D.C. 20231

Sir:

This is in response to the Notification of Missing Requirements Under 35 U.S.C. § 371 ("Notification") mailed on ¹⁴02 February 2002, regarding the Sequence Listing in the above-identified application. A copy of the Notification is enclosed.

In compliance with 37 CFR §§1.821-1.825, enclosed is a computer readable copy of the Sequence Listing for this application. The content of the computer readable copy is identical to that of the paper copy filed with the application.

Applicants assert that no new matter has been introduced in these submissions.

Applicants respectfully request favorable consideration and entry hereof.

1103326-0576

No fee should be due with this reply. However, the Commissioner is hereby authorized to charge any fees required with this paper to Deposit Account No. 23-1703.

Dated: March 20, 2002

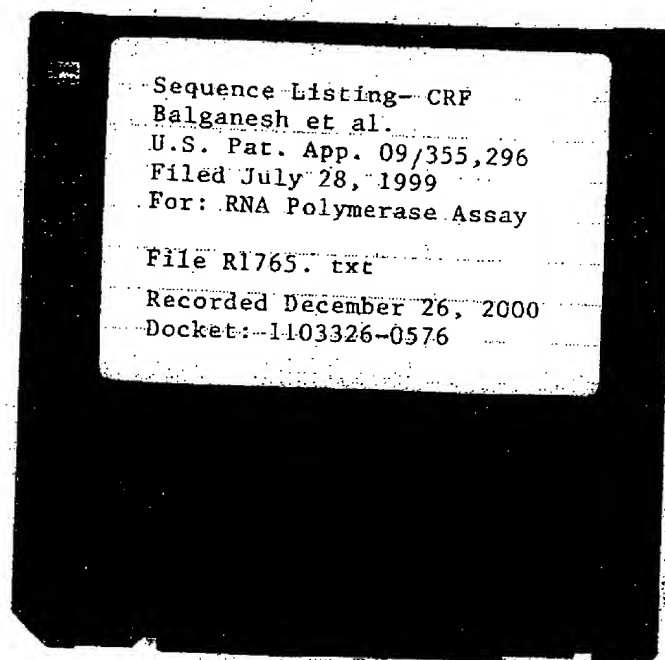
Respectfully submitted,

Thelma Chen Cleland

Thelma A. Chen Cleland
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Enclosure



Sequence Listing- CRF
Balganesh et al.
U.S. Pat. App. 09/355,296
Filed July 28, 1999
For: RNA Polymerase Assay

File R1765. txt

Recorded December 26, 2000
Docket: 1103326-0576

For 3 1/2" Disk



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From

To

Sequence Listing- CRF
Balganesh et al.
U.S. Pat. App. 09/355,296
Filed July 28, 1999
For: RNA Polymerase Assay

File R1765. txt
Recorded December 26, 2000
Docket: 1103326-0576

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PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

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PATENT DEPARTMENT

SEP 24 2001

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In re Application of
Tanjore BALGANESH et al.
U.S. Application No.: 09/355,296
PCT Application No.: PCT/SE99/00979
Int. Filing Date: 7 JUNE 1999
Priority Date: 9 JUNE 1998
Attorney's Docket No.
For: RNA POLYMERASE ASSAY

WITHDRAWAL OF THE
NOTIFICATION OF
ABANDONMENT

This decision is responsive to applicants' communication filed 16 October 2000, which is being treated as a petition under 37 CFR §1.181 to withdraw the holding of abandonment.

BACKGROUND

On 7 June 1999, applicants filed international application PCT/SE99/00979. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 December 1999. A Demand electing the United States was timely filed on 22 December 1999. Accordingly, the 30-month period for commencement of the national stage in the United States and payment of the basic national fee expired at midnight on 9 December 2000.

On 28 July 1999, a TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED OFFICE CONCERNING A FILING UNDER 35 U.S.C. 371 accompanied by, *inter alia*, a declaration and payment by deposit account of all required fees was received in the United States Elected Office (EO).

On 7 October 1999, a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) was mailed to applicants indicating that the present application had been accorded a 35 U.S.C. 102(e) date and a 35 U.S.C. 371 date of 28 July 1999.

Application No. 09/355,296

On 2 February 2000, the examiner mailed applicants a NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES. This Notice set a one-month period for reply, with extensions of time permitted under 37 C.F.R. §1.136(a). No response having been received and no extension of time obtained, the application became abandoned on 3 March 2000. A NOTICE OF ABANDONMENT was mailed on 2 October 2000.

On 16 October 2000, applicants filed the instant petition asserting that the holding of abandonment should be withdrawn as: 1) applicants never received the Office action mailed 2 February 2000 and nonetheless, 2) the processing of the application and the subsequent issuance of the 2 February 2000 Office action were premature as applicants expressly requested that the National Stage processing of the application not commence until the expiration of the applicable time limit under PCT Articles 22 and 39(1).

DISCUSSION

35 U.S.C. 371(b) provides that:

Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty.

35 U.S.C. 371(f) further provides that:

At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with.

Where the United States has been elected under Chapter II of the PCT prior to the expiration of 19 months from the priority date, the applicable time limit under PCT Articles 22 and 39(1) is 30 months from the priority date. See 37 C.F.R. §1.495.

The instant petition was timely filed within 2 months of the action complained of. Applicants' arguments on petition are well taken. The election of the United States was filed 22 December 1999, prior to the 19th month from the priority date of 7 June 1998. Furthermore, applicants' transmittal letter for entry into the National Stage expressly requested that "United States National processing of the application commence at the expiration of the applicable time limit under PCT Articles 22 and 39(1) according to the provisions of 35 U.S.C. 371(b)."

Application No. 09/355,296

Accordingly, it is concluded that the NOTICE OF ACCEPTANCE was mailed in error, and thus, the application proceeded to examination in error. Consequently, the NOTICE TO COMPLY mailed 2 February 2000 was mailed prematurely.

CONCLUSION

For the above reasons, the petition under 37 C.F.R. §1.181 is **GRANTED**. The NOTICE TO COMPLY mailed 2 February 2000 and the NOTICE OF ABANDONMENT mailed 2 October 2000 are hereby **VACATED**.

This application is being forwarded to the National Stage Processing Center of the International Division to make a determination as to whether the requirements for a sequence listing have been met.

After the sequence listing requirements have been met, the United States Designated/Elected Office will issue a NOTIFICATION OF ACCEPTANCE (FORM PCT/DO/EO 903) with a 35 U.S.C. 371(c) date of 9 December 2000, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 28 July 1999.

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Nancy Johnson
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PCT Legal Office



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